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MAYER BROWN LLP P.O. BOX 2828 CHICAGO, IL 60690			EXAMINER MEINCKE DIAZ, SUSANNA M	
			ART UNIT 3692	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/757,166  
Filing Date: January 13, 2004  
Appellant(s): KELLER ET AL.

\_\_\_\_\_  
Michael Word (Reg. No. 57,386)  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed July 28, 2008 appealing from the Office action mailed February 25, 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

Furthermore, the following new ground of rejection has been added.

**NEW GROUND OF REJECTION:**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

*Comiskey* explains that mental processes *per se* are not statutory under § 101. Mental processes must be tied into some other category of statutory subject matter in order to be potentially patentable under § 101. *Comiskey* specifically states, "However, mental processes -- or processes of human thinking -- standing alone are not patentable even if they have practical application." (See *In re Comiskey*, 84 USPQ2d, at 1678) *Comiskey* continues with the rationale that "the patent statute does not allow patents on particular systems that depend for their operation on human intelligence alone, a field of endeavor that both the framers and Congress intended to be beyond the reach of patentable subject matter. Thus, it is established that the application of human intelligence to the solution of practical problems is not in and of itself patentable." (See *In re Comiskey*, 84 USPQ2d, at 1679) Claims 1-11 are directed toward a mental process that is reliant on the operation of human intelligence and the process is not sufficiently tied to another statutory class nor does it transform underlying subject matter to a different state or thing; therefore, claims 1-11 do not fall into one of the statutory categories recognized as patentable under 35 U.S.C. § 101.

#### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

#### **(8) Evidence Relied Upon**

Burson-Marsteller's archived e-fluentials web site, retrieved from [URL: <http://web.archive.org/.../efluentials.com...>]. These web pages have been archived by web.archive.org on June 1, 2002, February 3, 2003, and February 15, 2003.

"Ninety Percent of Online Influentials Turn to Company Web Sites For Corporate Information, But Only 17 Percent Find Them Credible." PR Newswire, page NA, October 14, 2003.

Burson-Marsteller. "The e-fluentials." pages 1-11, © 2000, retrieved from [URL: [http://web.archive.org/web/20030604202709/efluentials.com/pdfs/efluentials\\_short.pdf](http://web.archive.org/web/20030604202709/efluentials.com/pdfs/efluentials_short.pdf)].

Official Notice is taken that it was old and well-known in the art of predictive modeling at the time of Applicant's invention to validate predictive variables (used to create an algorithm) on a second group of test subjects [now admitted prior art]; validation of the predictive variables helps to ensure that the model is taking into account the most effective variables at making accurate predictions [now admitted prior art].

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

[Please note that a rejection under 35 U.S.C. § 101 had been added and the statement of rejection under 35 U.S.C. § 103 has been clarified to show that Official Notice has been relied upon in the art rejection.]

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burson-Marsteller's e-fluentials<sup>SM</sup> research, as disclosed in (1) Burson-Marsteller's archived e-fluentials web site, retrieved from [URL: <http://web.archive.org/.../efluentials.com...>], herein referred to as "Burson-Marsteller's e-fluentials<sup>SM</sup> research," (2) the article "Ninety Percent of Online Influentials Turn to Company Web Sites For Corporate Information, But Only 17 Percent Find Them Credible," herein referred to as "Ninety Percent," and (3) Burson-Marsteller's "The e-fluentials." The web pages have been archived by web.archive.org on June 1, 2002, February 3, 2003, and February 15, 2003. "Ninety Percent" makes specific reference to the efluentials web site <http://www.efluentials.com> and to Burson-Marsteller's e-fluentials<sup>SM</sup> research and, therefore, is deemed to provide further information regarding features inherent to Burson-Marsteller's e-fluentials<sup>SM</sup> research, *in view of* Official Notice.

E-fluentials discloses a method for identifying from demographic data those individuals in a population having a greater probability than other individuals in the population of influencing the choices made by others comprising:  
[Claims 1, 6] a. determining if each individual in a first population is influential (Burson-Marsteller's e-fluentials<sup>SM</sup> research: Page 2 -- A quiz is offered to individuals to determine if each individual is an influential person, or "e-fluential. "Representing 10%

of the online population, approximately 11 million users, this group reaches more people on more topics than the average online users." Pages 5-23 show the results of an E-fluential analysis);

[Claims 2, 7] wherein determining if each individual in the first population is influential comprises:

a. formulating queries to be answered by an individual in the first population such that the answers by an individual in the population indicate whether the individual has a greater probability than other individuals in the first population of influencing choices made by others (Burson-Marsteller's e-fluentials<sup>SM</sup> research: Page 2 -- A quiz is offered to individuals to determine if each individual is an influential person, or "e-fluential. "Representing 10% of the online population, approximately 11 million users, this group reaches more people on more topics than the average online users");

b. providing the queries to individuals in the first population (Burson-Marsteller's e-fluentials<sup>SM</sup> research: Page 2 -- A quiz is offered to individuals to determine if each individual is an influential person, or "e-fluential; Page 3 -- E-fluential quiz questions are shown); and

c. analyzing the answers by the individuals in the first population to determine whether each of the individuals in the first population has a greater probability than other individuals in the first population of influencing choices made by others (Burson-Marsteller's e-fluentials<sup>SM</sup> research: Page 2 -- A quiz is offered to individuals to determine if each individual is an influential person, or "e-fluential. Pages 5-23 show the results of an E-fluential analysis);

[Claims 3, 8] wherein the choices made by others are selected from the group consisting of:

consumer product decisions, consumer service decisions, political issue decisions, political candidate decisions, personal finance decisions, investment decisions, real estate decisions, insurance decisions, travel decisions, and leisure decisions (Burson-Marsteller's e-fluentials<sup>SM</sup> research: Page 3 -- An individual is inquired about sending e-mails to politicians, e.g., a decision relating to politics, and making friends online, e.g., a leisure decision);

[Claims 4, 9] wherein the queries are based on factors selected from the group consisting of:

written or called any politician at the state, local, or national level; attended a political rally, speech, or organized protest of any kind; attended a public meeting on town or school affairs; held or run for political office; served on a committee for some local organization; served as an officer for some club or organization; written a letter to the editor of a newspaper or magazine or called a live radio or TV show to express an opinion; signed a petition; worked for a political party; made a speech; written an article for a magazine or newspaper; and been an active member of any group that tries to influence public policy or government (Burson-Marsteller's e-fluentials<sup>SM</sup> research: Page 3 -- An individual is inquired about sending e-mails to politicians, e.g., writing a politician (who is understood in the United States as being at the state, local, or national level), and sending e-mails to well-known news and media companies such as Time, Newsweek, or CNBS, e.g., writing a letter to a newspaper or magazine. The role of the



recited editor is not defined in such a way that it affects the structure or functionality of the claimed invention; therefore, any individual who receives e-mail at a well-known news and media company from the potential E-fluential individual can be interpreted as the recited "editor");

[Claims 5, 10] wherein the queries are based on factors selected from the group consisting of:

written or called any politician or contacted any government official at local regional or national level; attended a political rally, speech or event; attended a public meeting on town or school affairs; led or served on a committee on some local organization; written a letter to the editor of a newspaper or magazine or called a live radio or TV show to express an opinion; made a speech or gave a talk to a group; been an active member of a group that tries to influence public policy or create change in the community; asked a question in a public meeting; made a complaint to a store, company, or organization; made a sizable donation to a local or national organization; attended business lunches or dinners on a regular basis, and organized a special social event (Burson-Marsteller's e-fluentials<sup>SM</sup> research: Page 3 -- An individual is inquired about sending e-mails to politicians, e.g., writing a politician (who is understood in the United States as being at a local, regional, or national level));

[Claim 11] wherein the additional informational data is based on factors selected from the group consisting of:

household size, household income, occupation, presence of young adult in household, retail purchase activity, political affiliation, corrective lenses, golf participant,

cd player owner, personal or home computer owner, pc operating system type, religious or inspirational reader, religiously active, active in theater or performing arts, active in general arts or culture, active in current affairs or politics (Burson-Marsteller's e-fluentials<sup>SM</sup> research: Page 3 -- An individual is inquired about sending e-mails to politicians, e.g., active in politics).

Regarding claims 1 and 6, the Burson-Marsteller's e-fluentials<sup>SM</sup> research selects e-fluentials using a predictive algorithm based on their earlier research ("Ninety Percent": ¶ 7). This research has been used to identify which characteristics (i.e., variables) are most closely associated with e-fluentials ("Burson-Marsteller's e-fluentials<sup>SM</sup> research": Page 2 -- A quiz is offered to individuals to determine if each individual is an influential person, or "e-fluential." (Pages 5-23 show the results of an E-fluential analysis). "The e-fluentials" discusses how demographics can be used as part of the analysis differentiating e-fluentials from the general online population, e.g., based on age, income, and level of education ("The efluentials": page 10). "The efluentials" states, "The overall similarity of the two populations means that e-fluentials cannot easily be identified by demographics alone" ("The efluentials": page 10), which implies that demographic data and corresponding demographic variables are used, in addition to other information, to differentiate e-fluentials from a general population.

While the e-fluential references do not expressly disclose how the predictive algorithm is performed, it remains evident from these references that a smaller group of the most influential people are identified based on a collection of characteristics (or

variables) normally associated with the most influential people in a group. For example, the e-fluentials web site explains that e-fluentials frequently perform the activities that are the subject of the quiz used to identify e-fluentials, such as sending e-mails to politicians and well-known news and media companies (Burson-Marsteller's e-fluentials<sup>SM</sup> research: pages 3, 11, and 23) and similar assessments are made using demographic information ("The efluentials": page 10). Since these variables are determined to be useful and predictive of the most influential people in a group, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the e-fluentials research to provide demographic data for each individual in the first population, wherein the demographic data corresponding to a set of demographic variables and identify a plurality of predictive variables from the set of demographic variables such that the demographic data corresponding to the plurality of predictive variables substantially correlates to an individual in the first population being determined to be influential in order to practically apply Burson-Marsteller's past research to make future predictions regarding which people are the most influential within a group, thereby perpetuating the usefulness of such research over time. Additionally, Official Notice is taken that it was old and well-known in the art of predictive modeling at the time of Applicant's invention to validate predictive variables (used to create an algorithm) on a second group of test subjects [now admitted prior art]; validation of the predictive variables helps to ensure that the model is taking into account the most effective variables at making accurate predictions [now admitted prior art]. Therefore, the Examiner submits that it would have been

obvious to one of ordinary skill in the art at the time of Applicant's invention to modify e-fluentials' predictive model to incorporate the step of validating the plurality of predictive variables to determine a final set of predictive variables and to create a database scoring algorithm (e.g., by providing demographic data for a second population, wherein the demographic data for the second population corresponds to the final set of predictive variables and applying the database scoring algorithm to the demographic data for the second population to determine a group of influential individuals, wherein each test data vector corresponds to an individual in the second population, wherein the group of influential individuals represent a subgroup of the second population that is predicted to have a higher probability of being influential with respect to the second population in general) in order to help ensure that the model is taking into account the most effective variables at making accurate predictions.

Further regarding claim 6, the e-fluential references disclose the step of reformatting the plurality of predictive variables into numeric representations of gains ("Burson-Marsteller's e-fluentials<sup>SM</sup> research": Figs. F through K show percentage gains in activities, i.e., predictive variables, engaged in by e-fluentials versus the general online population; "The e-fluentials": Page 10 shows percentage gains related to varying demographics, i.e., predictive variables, more commonly representative of e-fluentials versus the general online population).

**NEW GROUND OF REJECTION:**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

*Comiskey* explains that mental processes *per se* are not statutory under § 101. Mental processes must be tied into some other category of statutory subject matter in order to be potentially patentable under § 101. *Comiskey* specifically states, "However, mental processes -- or processes of human thinking -- standing alone are not patentable even if they have practical application." (See *In re Comiskey*, 84 USPQ2d, at 1678) *Comiskey* continues with the rationale that "the patent statute does not allow patents on particular systems that depend for their operation on human intelligence alone, a field of endeavor that both the framers and Congress intended to be beyond the reach of patentable subject matter. Thus, it is established that the application of human intelligence to the solution of practical problems is not in and of itself patentable." (See *In re Comiskey*, 84 USPQ2d, at 1679) Claims 1-11 are directed toward a mental process that is reliant on the operation of human intelligence and the process is not sufficiently tied to another statutory class nor does it transform underlying subject matter to a different state or thing; therefore, claims 1-11 do not fall into one of the statutory categories recognized as patentable under 35 U.S.C. § 101.

#### **(10) Response to Argument**

Applicant argues that "none of the references – either alone or in combination – teaches or suggests the steps of 'identifying a plurality of predictive variables from the set of demographic variables....,' 'validating the plurality of predictive variables to determine a final set of predictive variables and to create a database scoring algorithm,' or 'applying the database scoring algorithm to the second population to determine a group of influential individuals....'" (Page 10 of the Appeal Brief) Applicant cites page 10 of "The e-fluentials" to assert that e-fluential teaches away from using demographic data. The Examiner respectfully disagrees. "The e-fluentials" discusses how demographics can be used as part of the analysis differentiating e-fluentials from the general online population, e.g., based on age, income, and level of education ("The efluentials": page 10). "The efluentials" states, "The overall similarity of the two populations means that e-fluentials cannot easily be identified by demographics alone" ("The efluentials": page 10), which implies that demographic data and corresponding demographic variables are used, *in addition to* other information, to differentiate e-fluentials from a general population.

Applicant challenges the Examiner's assertion by stating, "Rather than supporting the Examiner's assertion, it is clear that this passage as a whole supports the opposite conclusion: that demographic variables were not recognized in the prior art as predictive of the most influential people in the group...However, even a cursory examination of the reference reveals the Examiner's interpretation to be incorrect. First, it is clear from its context that this sentence is unrelated to the prior art method for identifying influentials...Second, the above passage itself suggests the futility of

attempting a correlation between demographics and influential status." (Page 12 of the Appeal Brief) The Examiner cites the section entitled "Demographics" from "The e-fluentials":

### III. DEMOGRAPHICS

Overall, e-fluentials do not differ much from the general online population. Both groups have an average age of about 42 years and an average household income of approximately \$53,000. Over half of both populations have a college degree (54% vs. 55% of online users), and a majority (69% vs. 62%) work full time.

However, e-fluentials do differ from typical users on certain characteristics. They are more likely than other users to be male (58% vs. 49%), and a slightly greater number of e-fluentials are likely to be single or to have never married (22% vs. 16%). Surprisingly, they are also somewhat more likely to have one or more children (54% vs. 48%).

The overall similarity of the two populations means that e-fluentials cannot easily be identified by demographics alone. As is true with the traditional Roper Influentials, they can only be found by closely examining their attitudes, perceptions and behaviors. (Page 10 of "The e-fluentials")

Clearly, "The e-fluentials" shows that an active correlation is made between e-fluentials (i.e., influential people) and non-influential people. While age and household income tend not to vary much among e-fluentials versus non-influential people, greater disparity among these two populations of individuals is found when comparing gender, marital status, and number of children demographics. Therefore, gender, marital status, and number of children are understood to be better predictive variables for identifying e-fluentials versus non-influential people (as compared to age and household income, for example), thereby supporting the Examiner's assertion that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify e-fluentials'

predictive model to incorporate the step of validating the plurality of predictive variables to determine a final set of predictive variables and to create a database scoring algorithm (e.g., by providing demographic data for a second population, wherein the demographic data for the second population corresponds to the final set of predictive variables and applying the database scoring algorithm to the demographic data for the second population to determine a group of influential individuals, wherein each test data vector corresponds to an individual in the second population, wherein the group of influential individuals represent a subgroup of the second population that is predicted to have a higher probability of being influential with respect to the second population in general) in order to help ensure that the model is taking into account the most effective variables at making accurate predictions.

Also, Examiner notes that, as per MPEP § 2144.03(C), the statements of Official Notice made in the art rejection have been established as admitted prior art since Applicant has not traversed the Examiner's assertions of Official Notice. More specifically, the following statements of Official Notice have been formally established on record as admitted prior art:

Official Notice is taken that it was old and well-known in the art of predictive modeling at the time of Applicant's invention to validate predictive variables (used to create an algorithm) on a second group of test subjects; validation of the predictive variables helps to ensure that the model is taking into account the most effective variables at making accurate predictions.

**(11) Related Proceeding(s) Appendix**



No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to

reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Susanna M. Diaz/  
Primary Examiner, Art Unit 3692

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

/Wynn Coggins/

Director, Technology Center 3600

Conferees:

Kambiz Abdi /K. A./

Supervisory Patent Examiner, Art Unit 3692

**NEW GROUND OF REJECTION:**

***Claim Rejections - 35 USC § 101***

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